

REMARKS

In respond to the Office Action mailed April 10, 2007, Applicants amended claims 1, 6-15, 17, 19, 20, and 25, cancelled claims 5, 18 and 32-48, and added new claims 49-59. Accordingly, claims 1-4, 6-17, 19-31 and 49-59 are pending, with claim 16 being withdrawn from consideration.

The Examiner rejected independent claim 1 and its dependent claims 2-15 and 17-31 under 35 U.S.C. §112, ¶ 2 as being indefinite.¹ Applicants amended claim 1 to obviate the rejection of claims 2-15 and 17-31. Therefore, Applicants request reconsideration and withdrawal of the rejection.

The Examiner rejected independent claim 1 and its dependent claims 2, 5, 15, 17-23, and 25-31 under 35 U.S.C. § 103(a) as being obvious over Jacobsen et al., US 6,530,934 ("Jacobsen") in view of Lanphere et al., US 2003/0185895 ("Lanphere I") or under 35 U.S.C. § 103(a) as being obvious over Lanphere et al., US 2004/0096662 ("Lanphere II") in view of Jacobsen.² Lanphere I and Lanphere II qualify as prior art under 35 U.S.C. § 102(e). The subject matter disclosed in these references, as well as the subject matter covered by claims 1, 2, 15, 17, 19-23 was, at the time the invention covered by these claims was made, owned by the same entity or subject to an obligation of assignment to the same entity. Accordingly, Applicants request reconsideration and withdrawal of these rejections. (See 35 U.S.C. § 103(c).)

The Examiner rejected claims 1, 2, 5, 8, 9, 15, 17-23, 25, 26, and 28-31 under 35 U.S.C. § 103(a) as being obvious over Jacobsen and Greene et al., US 2002/0177855 ("Greene"), in view of Smith et al., US 5,888,930 ("Smith").³ As amended, claims 1, 2, 8, 9, 15, 17, 19-23, 25, 26, and 28-31 cover compositions that include particle chains having at least two connected particles and a link that connects the at least two connected particles. At least one of the at least two connected particles has an interior region with pores having a mean size and a surface region with pores having a mean size, where the mean size of the pores of the interior region is greater than the mean size of the pores of the surface region.

¹ Applicants cancelled claims 5 and 18, so the rejection of these claims should be withdrawn.

² Applicants cancelled claims 5 and 18, so the rejection of these claims should be withdrawn.

³ Applicants cancelled claims 5 and 18, so the rejection of these claims should be withdrawn.

However, without conceding that such would be the case, even if one skilled in the art would have somehow been motivated to try to combine the teachings of these references, the result would not have been the subject matter covered by claims 1, 2, 8, 9, 15, 17, 19-23, 25, 26, and 28-31 for at least the following reasons.

The Examiner asserted that Jacobson discloses a particle chain. Without conceding that such is true, even if Jacobsen could be construed as disclosing a particle chain, Jacobson does not disclose how to make the particle chain. Moreover, Greene's methods of making his embolization device are not compatible with Smith's methods of making his beads. Greene's methods involve putting a polymer member in tubular holder followed by coaxially skewering the polymer member with the filamentous carrier, or disposing a filamentous carrier in a mold followed by transferring polymer under pressure into the mold. (See, e.g., Greene, paragraphs [0021] through [0024]). In contrast, Smith makes his particles by spraying polymer solution into a precipitation bath. (See, e.g., Smith, col. 3, lines 60-67 and col. 4, lines 50-53). Thus, one skilled in the art would not have been motivated to try to combine the references in the manner suggested by the Examiner to provide the subject matter covered by claims 1, 2, 8, 9, 15, 17, 19-23, 25, 26, and 28-31. Even if one skilled in the art had been so motivated, the references would not have enabled the person to make the subject matter covered by these claims. It is well established, however, that, for the prior art to render the subject matter covered by a claim obvious, the prior art must enable one skilled in the art to make and use the subject matter. (See, e.g., Beckman Instruments, Inc. v. LKB Produkter AB, 892 F.2d 1547, 1551 (Fed. Cir. 1989)).

In view of the foregoing, Applicants request reconsideration and withdrawal of the rejection of claims 1, 2, 8, 9, 15, 17, 19-23, 25, 26, and 28-31 under 35 U.S.C. § 103(a) as being obvious over Jacobsen and Greene, in view of Smith.

The Examiner rejected independent claim 1 and its dependent claims 2-15, 17-26, and 28-31 under 35 U.S.C. § 103(a) as being obvious over Jacobsen and Greene, in view of Smith, and in further view of Mazzocchi et al., US 6,605,102 ("Mazzocchi").⁴ For the reasons noted above, the combination of Jacobsen, Greene and Smith does not render the subject matter covered by claims 1-4, 6-15, 17, 19-26, and 28-31 unpatentable under 35 U.S.C. § 103(a). Mazzocchi does not cure the deficiencies of these references, at least because Mazzocchi does

⁴ Applicants cancelled claims 5 and 18, so the rejection of these claims should be withdrawn

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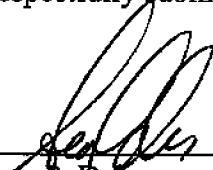
not disclose or suggest the compositions including the particle chains as covered by these claims, and certainly does not disclose or suggest how to make such particle chains. As a result, Applicants request reconsideration and withdrawal of this rejection.

Applicants believe the application is now in condition for allowance, which action is requested.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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Sean P. Daley
Reg. No. 40,978

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

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